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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,891	06/14/2005	Raymond Seltzer	HC/1-22816/A/CGC 2135/PCT	5156

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EXAMINER	
DEES, NIKKI H	

ART UNIT	PAPER NUMBER
1794	

NOTIFICATION DATE	DELIVERY MODE
07/10/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

joann.villamizar@ciba.com

Office Action Summary	Application No.	Applicant(s)	
	10/538,891	SELTZER ET AL.	
	Examiner	Art Unit	
	Nikki H. Dees	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 May 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,14-17,19 and 20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,14-17,19 and 20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The Amendment filed May 8, 2008, has been entered. Claims 1-4, 14-17, 19 and 20 are currently pending in the application. Claims 5-13 and 18 have been cancelled. The previous 35 USC 102 rejection of claims 1-4 and 14-17 has been withdrawn in view of Applicant's amendment to claim 1. The previous 35 USC 103 rejection of claims 19 and 20 has been withdrawn in view of Applicant's amendment to claim 1.

Claim Objections

2. Claims 19 and 20 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 19 claims the edible organic substance of claim 1 as a food containing fatty acid glycerides, edible fats and fatty oils. Amended claim 1 lists specific foods to be considered suitable for use in the invention. Claim 19 is broader than amended claim 1 and therefore not further limiting.

3. Claim 20 claims the edible organic substance of claim 1 as a pet food or animal feed. Amended claim 1 lists specific foods to be considered suitable for use in the invention. Claim 20 is broader than amended claim 1 and therefore not further limiting.

Claim Rejections - 35 USC § 103

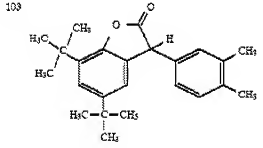
4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-4, 14-17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nesvadba (5,814,692) in view of Griffith et al. (2,768,084).

6. Nesvadba teaches 3-arylbenzofuranones including the compound shown below

103



7. Additional examples of related compounds are shown in Table 1 of Nesvadba. Nesvadba states that the compounds are suitable for stabilizing organic materials against oxidative degradation (col. 25 lines 19-21). Examples of materials that are suitable to be stabilized include naturally occurring organic materials such as animal and vegetable fats, oils and waxes (col. 29 lines 16-23).

8. Nesvadba further teaches that the compounds are to be added to the materials where degradation is to be retarded in amounts preferably ranging from 0.01 to 2% by weight (col. 28 lines 43-46). Nesvadba teaches that the compounds of his invention may be provided in combination with antioxidants including tocopherols (col. 29 item 1.4) and esters of 3,5-di-tert-butyl-4-hydroxyphenyl acetic acid with mono- or polyhedric alcohols (col. 30 item 1.16).

9. Nesvadba is silent as to the organic materials being a foodstuff as claimed in claim 1, or containing fatty acid glycerides, edible fats or fatty oils, as well as the organic substance being a pet food or animal feed.

10. Griffith et al. teach an antioxidant for stabilizing foodstuffs including mayonnaise, margarine, sausage and cheese spread, or any food product containing a large amount of fatty material subject to rancidity. They state that it is well-known that rancidity results primarily from products formed by oxidation (col. 1 lines 22-37).

11. As Nesvadba teaches an antioxidant compound for use with animal and vegetable fats, oils and waxes, and Griffith et al. teach antioxidants for use in foodstuffs containing animal and vegetable fats and oils, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted the antioxidant as taught by Nesvadba for use as the antioxidant in the foodstuffs as taught by Griffith et al. The use of the antioxidant as taught by Nesvadba in the foodstuffs would have yielded the predictable result of retarding oxidative degradation in any foodstuff, pet food, or animal feed containing fats and oils normally susceptible to oxidative degradation. The simple substitution of one antioxidant for another, absent

any evidence of unexpected results, is considered to be *prima facie* obvious. See MPEP § 2143 (B).

Response to Arguments

12. Applicant's arguments with respect to claims 1-4, 14-17, 19 and 20 have been considered but they are not persuasive.

13. As stated in the rejection, the substitution of a compound known as an antioxidant in foodstuffs where antioxidants are commonly used in order to obtain the predictable result of retarding oxidative degradation is considered to be *prima facie* obvious.

14. Regarding the argument that the teachings of Nesvadba are from a different field of endeavor, it is noted that known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art. See MPEP § 2141 (III) (F). In the instant application, one looking for antioxidants for use in food would consider an antioxidant taught for use with animal and vegetable fats, oils and waxes to be pertinent to the use in foodstuffs. Further, as the function of the compound in foodstuffs is predictable based on the teachings of Nesvadba, this provides further incentive for the use in any item, edible or otherwise, comprising animal and vegetable fats, oils and waxes.

15. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

16. One of ordinary skill in the art at the time the invention was made, taking into account the disclosure of Nesvadba wherein the claimed compound is disclosed as an antioxidant for use with animal and vegetable fats, oils and waxes, could have clearly envisaged the antioxidants for use in foodstuffs, as is claimed in the instant invention.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikki H. Dees whose telephone number is (571) 270-3435. The examiner can normally be reached on Monday-Friday 7:30-5:00 EST (second Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nikki H. Dees
Examiner
Art Unit 1794

/Carol Chaney/
Supervisory Patent Examiner, Art Unit 1794